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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,048	06/27/2003	Robert A. Juran	APPL 2 13460	7920
7590	04/11/2006		EXAMINER	
Thomas E. Young, Esq. Fay, Sharpe, Fagan, Minnich & McKee, LLP 7th Floor 1100 Superior Avenue Cleveland, OH 44114-2518			BOGART, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	
DATE MAILED: 04/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/608,048	JURAN ET AL.
	Examiner	Art Unit
	Michael G. Bogart	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 January 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) 7,8,15,16,24,25 and 32-40 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-6,9-14,17-23 and 26-31 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 27 June 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Drawings

The drawings are acceptable for examination purposes only. Once the application is allowed, new formal drawings must be submitted by Applicants.

Terminal Disclaimer

The terminal disclaimer filed on 03 February 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of application No. 11/108,522 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

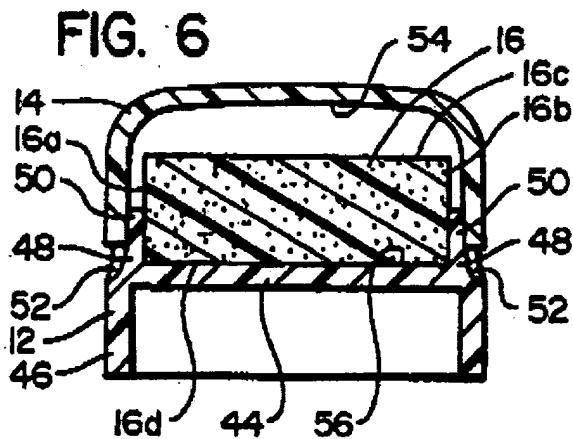
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 18, 21 and 26-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Winston (US 5,431,098 A).

Regarding claims 17 and 26, Winston teaches a stackable product applicator (10) comprising:

a rigid body comprising a base wall (44), a skirt (46) extending downwardly from said base wall (44) having a top edge, at least one upper side wall (50) extending upwardly from said base wall (44) having a top edge, a removable top (14) removably fixed to said side wall (50) around said entire top edge, said at least one upper side wall (50), said base wall (44) and said top (14) defining an upper compartment (54, 56) openably sealed by said removable top (14); said skirt (46) and said base wall (44) defining a lower compartment having an open bottom;

a compressible foam body (16) received in said upper compartment (56), said foam body (16) adapted to extend above said at least one upper side wall (50) top edge when in an uncompressed state and be contained in said upper compartment (56) in a compressed state; a quantity of fluid (ink) absorbed in said foam body(16); and
said skirt (46) being capable of surrounding and engaging the upper side wall (50) of an identical rigid applicator (10) whereby several applicators may be compactly stacked (see figure 6, below).



Regarding claims 18 and 27, the base wall (44) is integral with and effectively welded into the applicator body (12).

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Regarding claims 21 and 28, the foam body (16) has a bottom surface (16d) adhered to said base wall (44)(column 3, lines 59-68).

Claims 1, 3, 9, 11, 17, 19, 20, 21, 26, 30 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gueret (EP 1 044 625 A1). For the purposes of specifically enumerating the features of the reference, the English language equivalent to Gueret is employed herein (US 6,334,727 B1).

Regarding claims 1, 9 and 26, Gueret teaches a stackable applicator (1) comprising:

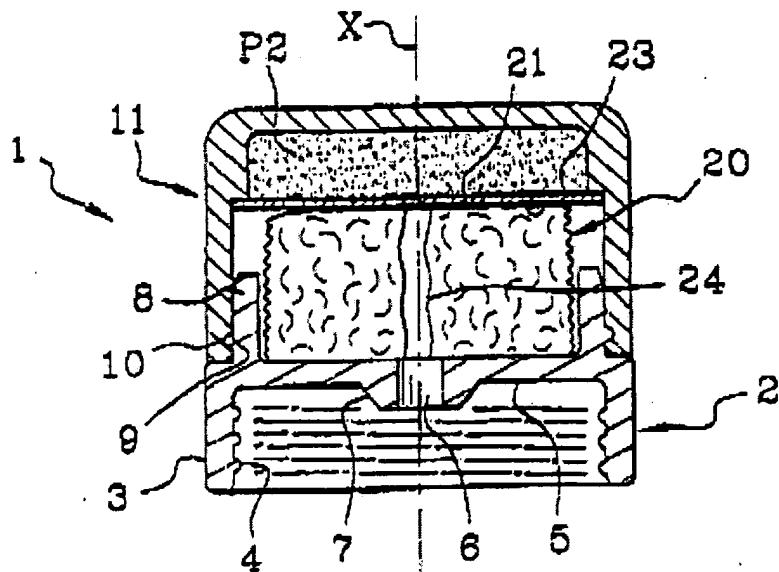
a rigid body (2) comprising a base wall (5), a skirt (3) extending downwardly from said base wall (5), at least one upper side wall (8) extending upwardly from said base wall (5) having a top edge, a top removably fixed to said side wall around the entire top edge, said at least one upper side wall (8) and said base wall (5) defining an upper compartment having an openable closed top (11), said skirt (3) and said base wall (5) defining a lower compartment having an open bottom;

a compressible foam body (20) received in said upper compartment, said foam body (20) extending above said at least one upper side (8) wall top edge when in an uncompressed state;

a quantity of fluid absorbed in said foam body (20)(abstract);

a sealing film (11, 23) fixed to said at least one upper side wall (8) top edge compressing said foam body (20) into said upper compartment and sealing said upper compartment; and

said skirt (3) being capable of surrounding and engaging the upper side wall of an identical rigid body whereby several applicators may be compactly stacked (see figure 1A, below).



Regarding claims 3, 11 and 21, Gueret teaches that the foam body is adhered to the base wall (5).

Regarding claim 17, Gueret teaches a removable top (11).

Regarding claims 19 and 20, Gueret teaches that the foam body (20) is compressed in said upper compartment when the removable top (11) is in place, wherein removal of the top (11) allows the foam body (20) to extend through the top opening.

Regarding claim 30, Gueret teaches a boss (24) capable of allowing injection of fluid into the applicator.

Regarding claim 31, Gueret teaches a rigid body (2) with a shoulder and said top (11) has the art recognized mechanical equivalent of a tab (10).

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret.

Gueret does not teach that the sealing film it heat sealed to the upper side top edge. Instead, it is sealed indirectly through cap means.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to substitute heat sealing for the mechanical seal because Applicant has not disclosed that heat sealing provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Gueret's applicator, and applicant's invention, to perform equally well with either mechanical seal taught by Gueret or the claimed heat sealing because both seals would perform the same function of sealing the upper compartment.

Therefore, it would have been *prima facie* obvious to modify Gueret to obtain the invention as specified in claims 2 and 10 because such a modification would have been

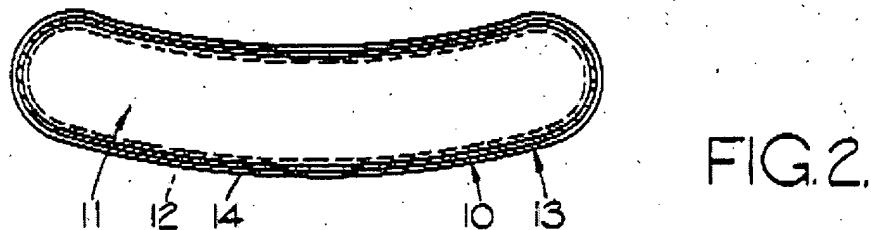
considered a mere design consideration which fails to patentably distinguish over the prior art of Gueret.

Claims 4-6, 12-14, 22, 23 and 29 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret as applied to claims 1, 3, 9, 11, 17, 19, 20, 21, and 26 above, and further in view of Boyd *et al.* (US 4,452,940).

Gueret fails to teach the concave design of the instant invention.

Boyd *et al.* teach a liquid container that has a concave construction (figures 1 and 2). This design makes the device easier to transport in a hip pocket. It also facilitates grasping the device.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to employ the concave design of Boyd *et al.* in the applicator of Gueret in order to make the device easier to grip and transport in a coat or hip pocket.



Regarding claims 6 and 14 Gueret teaches a rigid body (2) with a shoulder and said top (11) has the art recognized mechanical equivalent of a tab (10).

Response to Arguments

Applicant's arguments filed 23 January 2006 have been fully considered but they are not persuasive.

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Applicants assert that the additions to claim 17 define over Winston, but do not specify why. Applicants are directed to the enumerated rejection of claim 17, *supra*.

Applicants assert that neither Winston nor Gueret teach an applicator that is stackable with identical applicators. This argument is not persuasive because this is a functional limitation. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971). The applicator of Winston is made of plastic (Winston, col. 5, line 19) which is at least somewhat resilient and the skirt could be force-fitted onto the side walls of another applicator, even if it was not desirable to do so. In Gueret, the skirt (3) has sufficient dimensions to fit over side walls (8) of an identical applicator (see fig. 2D).

Applicants assert that Gueret does not teach a top around the entire top edge of the side wall wherein the side wall and base wall define an openable closed top. This is not persuasive because Gueret teaches a top (11) around the entire top edge of a side wall (8) which define a compartment therein, having an openable top (11).

Applicants assert that Gueret does not teach that the foam is compressed, however, the reference teaches that the foam (20) is compressed by film (23)(col. 6, lines 64-67).

Applicants assert that there is no suggestion to combine Boyd with Gueret. This argument is not persuasive because the device of Boyd is ergonomically shaped to facilitate carrying of the device by a user of the device. This concept is applicable to any item that is likely to be carried by a person.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

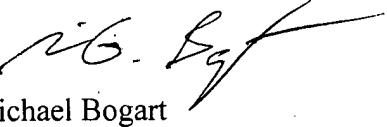
In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Bogart
4 April 2006

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

